

REMARKS

Claims 1-10 are pending in the above-identified application and have been subjected to restriction by the Office Action under 35 U.S.C. §121, 372 and 37 C.F.R. §1.499 as follows:

- I. Claims 1-5 and 8-10, drawn to the process of making a food product and the food product.
- II. Claims 6-7, drawn to the device.

In support of the present Restriction Requirement, the Office Action has alleged that “Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The process of group I does not need the different operational units having the specified features and the continuous chain of the device of Group II.”

As indicated hereinabove and in order to be fully responsive to the requirement for restriction imposed by the Office Action, applicant provisionally elects, with traverse, to prosecute the subject matter of Group I, i.e., Claims 1-5 and 8-10.

In addition, applicant reserves the right to file a divisional application directed to the non-elected subject matter.

Notwithstanding the foregoing, applicants hereby traverse, pursuant to 37 C.F.R. §§1.111 and 1.143, the requirement for a restriction and request reconsideration thereof in view of the following remarks.

Applicant respectfully requests that the Restriction Requirement be withdrawn since the subject matter of the two groups are linked to form a single general inventive concept, and thus a restriction requirement in this case is improper. This application is claiming priority of an international application, and as such pursuant to 37

C.F.R. §1.499, the Examiner can not issue a restriction requirement if the claimed subject matter has unity of the invention. In the present case, there is unity of invention between Groups I and II. More specifically, the subject matter of Groups I and II relate to pizza-type food products having the shape of a pouch, enclosing the pizza ingredients and whose stiffness after hardening of the dough allows it to be simultaneously held and consumed with no risk of leakage of the ingredients. Unity of invention under the PCT is satisfied when there is a technical relationship among the claimed inventions involving **one or more of the same** or corresponding special technical features.

The Office Action alleged lack of unity based on the conclusion that the process of Group I does not need the different operational units having the specified features and the continuous chain of the device of Group II. This is improper as the Office Action is looking to differences between the claimed inventions rather than to common special technical features. Unity of invention does not require all special technical features to be common. Rather, as set forth above, unity of invention is satisfied when there is a technical relationship among the claimed inventions involving one or more of the same corresponding special technical features. The requirement is not “all” special technical features must be in common. One example of different categories that satisfy unity of invention given by the PCT Applicant’s Guide, Volume 1, paragraph 131 is in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of said product and an independent claim for an apparatus or means specifically designed for carrying out the said process. It is respectfully submitted that it is this combination of independent claims which is found in the present application. And as such, with said claims satisfying the requirements of unity of invention under the PCT, it is respectfully requested that the restriction requirement be withdrawn.

In addition to the above, the courts have recognized that it is in the public interest to permit applicants to claim several aspects of their invention together in one

application, as the applicants have done herein, so as to encourage applicants to provide a more detailed disclosure of all aspects of their invention. The CCPA has observed:

We believe the constitutional purpose of the patent system is promoted by encouraging applicants to claim, and therefore to describe in the manner recognized by 35 U.S.C. §112, all aspects as to what they regard as their invention, regardless of the number of statutory classes involved.

In re Kuehl, 456 F.2d 658, 666, 117 U.S.P.Q. 250, 256 (CCPA 1973).

Applicants respectfully suggest that in view of the continued increase of official fees and the potential limitation of applicants' financial resources, a practice which arbitrarily imposes a Restriction Requirement may become prohibitive and thereby contravenes the constitutional intent to promote and encourage the progress of science and the useful arts. Moreover, under the regulatory changes as a consequence of the General Agreement on Trade and Tariffs (GATT), the applicants are required to either conduct simultaneous prosecution with attendant filing fees and costs or face a compromise of the term of their patent assets.

It is vital to all applicants that Restriction Requirements issue only with the proper statutory authorization, because patents issuing on divisional applications which are filed to prosecute claims that the Examiner held to be independent and distinct can be vulnerable to legal challenges alleging double-patenting. The third sentence of U.S.C. §121, which states that a patent issuing on a parent application "shall not be used as a reference" against a divisional application or a patent issued thereon, does not provide comfort against such allegations. The Court of Appeals for the Federal Circuit has declined to hold that §121 protects a patentee from an allegation of same-invention-double-patenting,

Studiengesellschaft Kohle mbH v. Northern Petrochemical Co., 784 F.2d 351, 355, 288

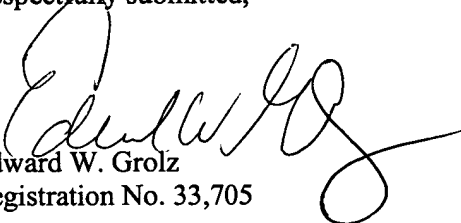
U.S.P.Q. 837, 840 (Fed. Cir. 1986); and in Gerber Garment Technology Inc. v. Lectra

Systems Inc., 916 F.2d 683, 16 U.S.P.Q. 2d 1436 (Fed. Cir. 1990), that court held that §121 does not insulate a patentee from an allegation of "obviousness-type" double patenting, and in fact affirmed the invalidation on double patenting grounds of a patent that had issued from a divisional application filed following a restriction requirement. Furthermore, it is far from clear that the step of filing a terminal disclaimer is available to resolve a double patenting issue that arises after the issuance of a patent on the divisional application.

All these considerations indicate that the imposition of a restriction requirement with inadequate authority can lead to situations in which applicant's legitimate patent rights are exposed to uncertainty and even extinguished. Accordingly, to protect patentee's rights and to serve the public's interest in the legitimacy of issued patents, applicant respectfully urges the Examiner not to require restriction in cases such as the present application.

Hence, it is respectfully requested that the United States Patent and Trademark Office reconsider and withdraw the requirement for restriction pursuant to 35 U.S.C. §§121 and 372 and provide an action on the merits with respect to all of the claimed subject matter.

Respectfully submitted,


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